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LOWENSTEIN SANDLER PC
65 Livingston Avenue
Roseland, NJ 07068

In re Application of	:	
GADDY et al	:	DECISION ON
Int. Application: PCT/US2005/007655	:	
Application No.: 10/590,781	:	
Int. Filing Date: 09 March 2005	:	REQUEST UNDER
Priority Date: 09 March	:	
Attorney's Docket No.: 19008-39	:	
For: SYSTEM AND METHOD...	:	
SYMMETRIC FIREWALLS	:	37 CFR 1.497(d)

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE" filed on 24 September 2007, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Chang Feng in the executed declaration.

BACKGROUND

On 9 March 2005, applicant filed international application No. PCT/US2005/007655, which claims a priority date of 9 March 2004.

On 25 August 2006, applicant filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee. No executed oath or declaration was filed at such time.

On 20 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.47(a) and (b), identifying the application by International application number and international filing date" must be submitted within two months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 09 May 2007, applicant filed a "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371," which included, *inter alia*, an executed declaration.

On 27 August 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) indicating that the oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that inventor Chang Feng not on IA. No notification of a change in application.

On 24 September 2007, applicant filed a "REQUEST FOR ADDITION OF INVENTOR," which included, *inter alia*, a statement under 37 CFR.1.497(d) adding Chang Feng who was not originally listed in the PCT application.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (1) and (3) but not item (2) under 37 CFR 1.497(d).

With respect to item (1), the statement submitted by Chang Feng is sufficient because the statement states that the error in inventorship occurred without a deceptive intent.

With respect to item (2), applicant has not provided the processing fee of \$130.00 because no check or authorization to charge a Deposit Account has been provided. The statement "any additional fees due, via the U.S. Patent and Trademark Office e-filing system (EFS- Web)" is insufficient.

With respect to item (3), Clique Communication, the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers establishing their right to take action under 37 CFR §3.73(b) because the assignment has been recorded in USPTO at Reel/Frame 019266/0310.

Accordingly, the request is not deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'R. Bacares', is written over the printed name.

Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 272-0459